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09/678,363	09/29/2000	Philippe Vivarelli	99RSS340	4672
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CHRISTOPHER J. ROURK			JONES, DAVID	
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.			ART UNIT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,363

Applicant(s)

VIVARELLI, PHILIPPE

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 March 2001.  
2a) This action is FINAL. 2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-20 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 29 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



Primary PATENT EXAMINER

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US 6,483,600) and further in view of Intel White Paper – T38 and the Future of Fax.

Regarding claim 1, Schuster teaches a fax over Internet system, comprising:

a first Internet service provider(data network gateway, fig. 1A, #30, column 4, lines 59-65), the client connects to the first Internet service provider;

a second Internet service provider #70 that is operable to support a T38 protocol;

an Internet protocol network #50, the first Internet service provider and the second Internet service provider are communicatively coupled via the Internet protocol network;

a telephone network provider (column 4, lines 35-47);

a fax machine #80 (column 4, lines 35-47) that is operable to be communicatively coupled to the second Internet service provider via the telephone network provider;

a fax over Internet protocol session (column 13, lines 21-59) is maintained between the client and the fax machine via the first Internet service provider, the Internet protocol network,

the second Internet service provider, and the telephone network provider. Schuster utilizes T. 38 from the gateway or ISP's, does not explicitly show that the client is T.38 capable.

Whereas, Intel states (page 5, 4<sup>th</sup> paragraph) that T.38 compliant firmware client driver could be downloaded as 4/30/99 date of publication. Further, on page 3, paragraph 4, shows the architectural framework of the T.38 recommendation. A traditional Group 3 facsimile terminal is connected to a gateway, emitting a facsimile through an IP network to a receiving gateway. The receiving gateway makes a PSTN call to the receiving Group 3 facsimile equipment on the other side of the network. Once the PSTN calls are established on both ends, the two Group 3 terminals are virtually linked. The terminals establish the T.30 session and negotiate capabilities for fax functions like positive page confirmation and minimal call elongation. And as defined in the T.38 recommendation, a connection on one or both ends of the transmission is a fax-enabled device like a PC, which is directly connected to an IP network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the T.38 compliant firmware client driver of Intel with fax device of Schuster.

The motivation/suggestion for doing so would have been to provide real-time fax, compliant with ITU T.38 standard for voice-and-fax-over-IP (Intel page 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Intel T.38 compliant firmware client driver with the fax device of Schuster to obtain the invention as specified in claim 1.

**Regarding claim 2**, Schuster teaches a fax over Internet system, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the fax device

contains a memory, and as noted above in claim 1, that the T.38 compliant firmware client driver is able to be downloaded, it well known to be downloaded that it has be saved to memory.

**Regarding claim 3**, Schuster teaches a fax over Internet system, wherein the Internet protocol network comprises a private network that is operable using an Internet protocol. In column 4, lines 48-58, Schuster teaches that the system can realized using a private IP network within a LAN or WAN configuration.

**Regarding claim 4**, Schuster teaches (column 4, lines 48-58) a fax over Internet system, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the system as taught by Schuster includes the ability to connect to the first gateway through an ISDN, which is well known to be used within LAN or WAN.

**Regarding claims 5 and 17**, Schuster teaches (column 4, lines 48-58) a fax over Internet system, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the system as taught by Schuster includes the ability to connect to the first gateway through an ADSL, which is well known to be used for a private connection over the Internet.

**Regarding claims 6, 10 and 20**, Schuster teaches a fax over Internet system. But does not explicitly teach the ability to maintain at least one additional Internet protocol session.

Whereas, Intel teaches (page 5, paragraph 6) that the DSP chips on the IP Link Board have the ability to handle multiple coders at the same time. That means some of the channels handled by a single DSP can be voice calls and others can be fax transmissions. It is also possible to switch automatically between voice and fax without breaking the connection. For example, if a fax transmission comes in during a voice call, the system automatically switches to

fax mode. The user does not need to hang up. After the fax transmission is completed, the connection still exists and the user can continue to talk. Naturally, it is also possible to use only the fax-over IP (or voice-over-IP) capabilities of an Intel® Dialogic® IP telephony board.

**Regarding claim 7.** Schuster teaches a fax over Internet system, Schuster does not explicitly detail that the client device is a PC or a Laptop. Whereas, Intel teaches (page 3, paragraph 4) that the system can be incorporated either at one end or both with T.38 compliant protocol devices, such as a PC, which is well known to also be a laptop computer.

**Regarding claim 8.** Schuster teaches a fax over Internet system, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the client device would contain a modem with firmware. And as taught (page 5, 4<sup>th</sup> paragraph) by Intel that the T.38 compliant firmware client driver was able to be downloaded.

**Regarding claim 9 and 16,** Schuster teaches a fax over Internet method and system, comprising:

a first Internet service provider, (data network gateway, fig. 1A, #30, column 4, lines 59-65) a client #20 connects to the first Internet service provider;

a second Internet service provider #70;

an Internet protocol network #50, the first Internet service provider and the second Internet service provider are communicatively coupled via the Internet protocol network as shown in fig. 1A;

a fax machine that is operable to be communicatively coupled to the second Internet service provider #80 (column 4, lines 35-47);

In column 13, lines 21-41, teaches that the typical transmitting facsimile device #20 transmits using V21 protocol, it is well known that to be able to transmit or receive data that protocol driver must be installed for example the driver shown in fig. 4, #116 (column 13, lines 60-67), the client maintains a fax over Internet protocol session (column 13, lines 21-59) with the fax machine using the fax over Internet protocol client driver. Schuster utilizes T. 38 from the gateway or ISP's, does not explicitly show that the client is T.38 capable.

Whereas, Intel states (page 5, 4<sup>th</sup> paragraph) that T.38 compliant firmware client driver could be downloaded as 4/30/99 date of publication. Further, on page 3, paragraph 4, shows the architectural framework of the T.38 recommendation. A traditional Group 3 facsimile terminal is connected to a gateway, emitting a facsimile through an IP network to a receiving gateway. The receiving gateway makes a PSTN call to the receiving Group 3 facsimile equipment on the other side of the network. Once the PSTN calls are established on both ends, the two Group 3 terminals are virtually linked. The terminals establish the T.30 session and negotiate capabilities for fax functions like positive page confirmation and minimal call elongation. And as defined in the T.38 recommendation, a connection on one or both ends of the transmission is a fax-enabled device like a PC, which is directly connected to an IP network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the T.38 compliant firmware client driver of Intel with fax device of Schuster.

The motivation/suggestion for doing so would have been to provide real-time fax, compliant with ITU T.38 standard for voice-and-fax-over-IP (Intel page 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Intel T.38 compliant firmware client driver with the fax device of Schuster to obtain the invention as specified in claims 9 and 16.

**Regarding claim 11**, Schuster teaches a fax over Internet system, wherein the Internet protocol network comprises the Internet #50 (column 4, lines 48-58).

**Regarding claim 12**, Schuster teaches a fax over Internet system, wherein the Internet protocol network comprises a private network that is operable using an Internet protocol. In column 4, lines Schuster teaches that the system can be realized using a private IP network within a LAN or WAN configuration.

**Regarding claim13**, Schuster teaches a fax over Internet system, although it is not explicitly disclosed by Schuster that the fax device is a personal computer. Whereas, Intel teaches (page 3, paragraph 4) that as defined in the T.38 recommendation, a connection on one or both ends of the transmission is a fax-enabled device like a PC, which is directly connected to an IP network.

**Regarding claim 14**, Schuster teaches a fax over Internet system, but does not explicitly detail that client device protocol is T.38. Whereas, Intel teaches that a connection on one or both ends of the transmission is a fax-enabled device (T.38) like a PC, which is directly connected to an IP network.

**Regarding claim15**, Schuster teaches a fax over Internet system, wherein the client connects (column 6, lines 30-32) to the first Internet service provider using a public switched telecommunications network.

**Regarding claim 18**, Schuster teaches a fax over Internet method, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the system of Schuster as shown is only showing one client device for example purposes, but the system could easily include more than one the at least one additional fax machine comprises an Internet capable fax machine. Intel White Paper shows (page 3, figure 2) three computers connected to the system.

**Regarding claim 19**, Schuster teaches a fax over Internet system, wherein the Internet protocol network comprises a private network that is operable using an Internet protocol. In column 4, lines Schuster teaches that the system can be realized using a private IP network within a LAN or WAN configuration.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

ITU-T T.38, "Procedures for real-time Group 3 facsimile communication over IP networks".

ITU-T T.38, Amendment 1, "Procedures for real-time Group 3 facsimile communication over IP networks".

ITU-T H.323, "Packet-based multimedia communications systems".

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Jones



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PATENT EXAMINER  
Primary